

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS & INTERFERENCES

In re Application of

Customer No. 27182

Perrot et al.

Confirmation No. 9162

Serial No.: 10/657,085

Group Art Unit: 1795

Filed: 9/9/2003

Examiner: McDonald, Rodney G.

Title: METHOD OF MANUFACTURING Docket No. 21376
AN EXTENDED LIFE SPUTTER
TARGET ASSEMBLY AND
PRODUCT THEREOF

REPLY BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is a Reply Brief filed in response to the new ground of rejection raised in the Examiner's Answer of November 9, 2007. A Petition to Revive the Application is concurrently filed herewith.

The Commissioner is authorized to charge any fees that may be required with this paper, and to credit any overpayment to Deposit Account No. 16-2440.

TABLE OF CONTENTS

	<u>Page</u>
I. STATUS OF CLAIMS	1
II. NEW GROUND OF REJECTION TO BE REVIEWED ON APPEAL.....	2
III. ARGUMENTS.....	3,
IV. CONCLUSION	5

I. STATUS OF CLAIMS

Claims 1-6, 8-12 and 14-17 are pending, as claims 7, 13 and 18 have been previously cancelled. Thus claims 1-6, 8-12 and 14-17 are subject of the present appeal. A copy of the claims is set forth in the previously submitted Appeal Brief.

II. NEW GROUND OF REJECTION TO BE REVIEWED ON APPEAL

1. Whether claims 1-6, 8-12 and 14-17 are properly objected to under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the written description requirement.

III. ARGUMENTS

New Ground of Rejection

As noted above, the newly added ground of rejection is claims 1-6, 8-12 and 14-17 are properly objected under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the written description requirement.

The Examiner's Rationale

According to pages 8-9 of the Examiner's Answer:

"[I]t is the Examiner's position that the drawings are not to scale and do not support the range 'of at least fifty percent'. It appears from Fig. 4 that the majority of the surface of target is frusto-conical, but the range of how much is not supported by the specification or the drawings."

The MPEP states that PROPORTIONS OF FEATURES IN A DRAWING ARE NOT EVIDENCE OF ACTUAL PROPORTIONS WHEN DRAWINGS ARE NOT TO SCALE. When the reference does not disclose that the drawings are to scale and is silent to dimension, arguments based on measurement of the drawing features are of little value. (Emphasis added.)

The Argument

The objective standard for determining compliance with the written description is "does the description clearly allow persons of ordinary skill in the art to recognize that he or she invented what is claimed." See *In re Gosteli*, 872 F.2d 1008 (Fed. Cir. 1989). An applicant may show possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention. See *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997).

In the present application, and as shown in Fig. 4, of Appellants' Specification, the sloped region of the front surface exceeds the flat portion. Thus, clearly the frusta-conical portion is at least fifty percent. Appellants are not relying on the figures to state a precise range based on the showing in the drawings or the exact location of an element to form the basis of such disclosure, but simply to show that at least half on the target surface is frusta-conical. Clearly this is described in the figures, and acknowledged by the Examiner in the citation of the Examiner's Answer quoted above.

As to the reliance on the MPEP for the purported allegation of lack of support because the figures are not to scale is entirely misplaced. In this regard, the MPEP section cited is Section 2125 entitled "Drawings as Prior Art". Thus, this section has nothing to do with support in the context of written description, but rather it is the utilization of the drawings found in a piece of prior art in support of a *prima facie* case of unpatentability. The circumstances are different and irrelevant to support the present ground of rejection.

Lastly, Appellants note that this new ground of rejection is a reinstatement of a previously withdrawn rejection. It is unclear to Appellants why this rejection has been resurrected given that the factual context is unchanged.

Accordingly, for the foregoing reasons reversal of this new ground of rejection is in order and it is respectfully requested.

IV. CONCLUSION

In view of the foregoing, Appellants respectfully submit that the subject matter claimed was described in the specification in such a way as to convey to one skilled in the art, at the time the application was filed, possession thereof. Accordingly, reversal of the Examiner's §112, first paragraph, rejection is earnestly solicited.

Respectfully submitted,



Lurie A. Schwartz
Attorney for Applicants
Reg. No. 43,909

Praxair, Inc.
39 Old Ridgebury Road
Danbury, CT 06810
Phone: (203) 837-2115
Fax: (203) 837-2545

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